



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/021,237	03/03/87	SHOFFNER	J 56929

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EXAMINER	
TAYLOR, D	
ART UNIT	PAPER NUMBER
351	F

DATE MAILED:

12/02/88
DS

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 10/13/88 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449 4. Notice of informal Patent Application, Form PTO-152
5. Information on How to Effect Drawing Changes, PTO-1474 6.

Part II SUMMARY OF ACTION

1. Claims 11 - 20 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 11 - 20 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. These drawings are acceptable; not acceptable (see explanation).

10. The proposed drawing correction and/or the proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved. disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

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Claims 11, 12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 11, a portion of the claim between lines 5 and 6 appears to be missing. Also, line 5, "form" apparently should be --from--. In claims 12 and 20, these claims are improper Markush claims. A Markush type of claim can only be employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 11-14, 19 and 20 are rejected under 35 U.S.C. 103 as being unpatentable over Shaw. Shaw teaches a pair of telescopically related inner and outer

cylindrical portions, shown in Fig. 1. The inner portion being formed from a lubricous polymeric material. The term "coextruded" in line 1 of the claim is a method limitation as to how the tube is made and is given no patentable weight because there is nothing recited in the claim that gives any significance to how the tube is made. Also, the term "essentially", recited in line 3, is meaningless. It is not clear to the examiner what concept or limitation Applicant is attempting to convey by this term since there is nothing in the claim that further modifies this term. Moreover, the specification teaches the use of more than two layers. The reasons set forth in paper No. 5 for the rejection of claims 12-14, 19 and 20, are considered applicable to these claims.

Claims 15 and 16 are rejected under 35 U.S.C. 103 as being unpatentable over Shaw as applied to claim 11 above, and further in view of Redding et al for reasons as set forth in paper No. 5.

Claims 17 and 18 are rejected under 35 U.S.C. 103 as being unpatentable over Shaw as applied to claim 11 above, and further in view of Kleykamp for reasons as set forth in paper No. 5.

Applicant's arguments filed Oct. 13, 1988 have been fully considered but they are not deemed to be persuasive. Merely to eliminate a portion of the teaching of Shaw which is not considered necessary is not con-

sidered to be an inventive step. Applicant's claims recite the inner and outer layer as taught by Shaw. There is nothing in Applicant's claims that indicate that any new or different results are obtained by the claimed structure which would result when portions of the Shaw structure are eliminated.

The Court Decisions, i.e. *in re Wright*, cited by Applicant has been considered. However, the claimed structure is the primary consideration when determining patentability of a claim and court decisions cannot be used to impart patentability to claims which do not define over the art. Shaw clearly does teach the use of fluoropolymers or other materials for friction control. Shaw teaches that one of the uses of the inner tube is to reduce abrasion. If abrasion is reduced, friction is obviously controlled.

The secondary references were not cited to teach any reduction in friction. Shaw was cited to teach this. Also, it is noted that there is nothing in the claims that indicates that friction between conduits is being reduced. Applicant appears to be arguing features which are not recited in the claims. Further, Shaw clearly addresses the problem of lubricity.

It is not necessary to have a teaching that a reference is deficient before it can be modified. The modification of a reference is usually for the purpose

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of adding a desirable feature.

Finally, Applicant's attempt to circumvent the Shaw reference by language which has no real significance is not persuasive toward the allowance of the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner D. Taylor at telephone number 703-557-6200.

Taylor/mm
11-22-88

Dennis L. Taylor
Dennis L. Taylor
Primary Examiner
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